REMARKS

Claims 1-4, 6-22, 24-34, 53 and 54 are currently pending. Claims 53 and 54 are newly added.

1. The present Final Office Action appears to be incomplete and lacks clarity with regard to several claim rejections. As such, Applicants respectfully request that, if the below comments are not considered convincing, a new office action be issued.

Specifically, Applicants traversed an apparent Official Notice. The Final Office Action provides no comment regarding the traversed Official Notice, rendering the Final Office Action incomplete.

In addition, claims are rejected under 35 U.S.C. 102(b) as being anticipated by Napier (US 3,357,791). However, the rejection cites Bugosh, stating that "Bugosh teaches" use of beohmite in aqueous coatings. Such a rejection lacks clarity.

Further, the Final Office Action rejects claims, such as claim 4, which recites a latex paint comprising an acrylic, under 35 U.S.C 102(e) based on poly vinyl alcohol examples of Yoshino et al. (US 6,576,324). Such a rejection lacks clarity. As noted at MPEP 707.07(d), a plurality of claims should not be grouped in a common rejection, unless the rejection is equally applicable to all claims in the group.

As such, Applicants respectfully request a new office action be issued in the event that the below comments are not considered convincing. (See generally MPEP 707.07 and 710).

2. Claims 1-4, 6-22, and 24-34 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The PTO cites Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 18 USPQ 2d 1016 (Fed. Cir. 1991), herein "Amgen". In fact, the analysis of the term "about" is specific to the facts of Amgen and the decision clearly states that the holdings do not preclude any and all uses of the term "about" in patent claims, since such a term may be acceptable in appropriate fact situations. Moreover, in contrast to the assertion by the PTO,

Amgen does not appear to address whether "at least" and "about" may be used together. Indeed, a query of PTO records shows that the phrase "at least about" is present in the claims of 68,461 patents issued since 1976 with patents issued as late as June 26, 2007. As such, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §112, second paragraph rejection.

3. Claims 1-4, 8-11, 13-19, 22, 25, 26 and 28-33 were rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Bugosh (US 2,915,475); and claims 1-4, 6-22, and 24-34 were rejected under 35 U.S.C. §103(a) as obvious over Bugosh. Applicants respectfully traverse these rejections for the following reasons.

Present claim 1 is directed to a surface coating solution including a surface coating base and boehmite particles provided in the surface coating base. The boehmite particles include mainly anisotropically-shaped particles having an aspect ratio of at least 3:1. The surface coating solution has a flow and leveling of at least about 6 mils.

Present claim 22 is directed to a surface coating solution including boehmite particles comprising mainly anisotropically-shaped particles having an aspect ratio of at least about 3:1 and a longest dimension of at least 50 nm. The surface coating solution has a flow and leveling of at least about 6 mils.

Bugosh is directed to fibrous aluminum monohydrate particles. Bugosh further discloses that fibrous boehmite can be used as reinforcing filler in making plastic films, coatings, paints, adhesives, or other plastic articles. The fibrous boehmite may be mixed with aqueous dispersions of polymers. (Bugosh, col. 29, ll. 1-21). However, Bugosh is silent regarding characteristics of the coatings and paints, such as flow and leveling, sag resistance, and set-to-touch dry time characteristics.

While, as disclosed by Bugosh, it may have been known to incorporate boehmite into coatings, paints, and adhesives, Applicants have discovered that anisotropic boehmite particles, and in particular, anisotropic boehmite particles formed using boehmite seed crystals, when used in the process outlined in the application, advantageously produce surface coatings having desirable characteristics, such as desirable flow and leveling, sag resistance, set-to-touch dry

time, and shear viscosity recovery. Specifically, Applicants have discovered that such desirable properties in a surface coating, such as a latex paint, result from activating anisotropic boehmite particles prior to incorporating such particles into a latex solution.

While the PTO dismissed Applicants assertions regarding activation of the anisotropic boehmite in the Final Office Action, the claimed properties result from such activation, making the assertions relevant. Bugosh is silent regarding processing of a surface coating and merely states that boehmite particles may be added to coatings, paints, and adhesives. Further, Bugosh provides little specific teaching regarding the formulation of coatings, paints, and adhesives, other than that plastic materials are benefited by incorporation of 1-40% fibrous boehmite. (Bugosh, col. 29, ll. 5-10). In order to inherently disclose a given property, a reference must necessarily have the recited characteristics. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. (See generally, MPEP 2112). Bugosh lacks teaching that necessarily results in coating solutions having the claimed properties.

As such, Bugosh fails to teach or suggest, either explicitly or inherently, the claimed surface coating solution of claim 1 and of claim 22. In particular, Bugosh fails to teach or suggest a surface coating solution that includes anisotropic boehmite particles and that has flow and leveling of at least about 6 mils.

Furthermore, the PTO failed to address Applicants objection to the Official Notice apparently asserted in the previous Office Action. The PTO appeared to assert through Official Notice that the claimed properties of flow and leveling, sag resistance, dry time, shear viscosity recovery, and pH are inherent to paint formulations. In fact, Applicants have provided an example TEW-464 (Present Application, Table 1) that demonstrates that such properties are not inherent to paints. In addition, Applicants respectfully traverse such Official Notice and request a reference in accordance with MPEP 2144.03. In particular, no specific factual findings predicated on sound technical and scientific reasoning to support the PTO's conclusion is provided.

In addition, the PTO appears to ignore many of the dependent claims in formulating its rejection. The PTO asserts that the aqueous paint of Bugosh containing 40% boehmite

inherently possesses the claimed flow and leveling properties. However, claims 9, 10, 11, and 26 recite amounts of beohmite that are less than 40%. A reasoned statement regarding the rejection of such claims, among others, is not provided, leading to a lack of clarity in the rejection.

For at least the foregoing reasons, claims 1-4, 6-22, and 24-34 are patentable over Bugosh. As such, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §102(b) and 35 U.S.C. §103(a) rejections.

4. Claims 1-4, 6-9, 12 and 15-21 were rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Yoshino et al. (US 6,576,342; herein "Yoshino") and claims 1-4, 6-12 and 15-21 were rejected under 35 U.S.C. §103(a) as obvious over Yoshino. Applicants respectfully traverse these rejections for the following reasons.

Yoshino is directed to a printing medium provided on a base material with a porous ink receiving layer which includes an alumina hydrate and a binder. Yoshino is silent regarding flow and leveling values, sag resistance and dry time, shear viscosity recovery, and pH. However, the PTO asserts that the composition of Yoshino inherently meets the claimed flow and leveling values, sag resistance, dry time, low shear recovery and pH.

In order to inherently disclose a given property, a reference must necessarily have the recited characteristics. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. (See generally, MPEP 2112). As above, the claimed properties result from use of particular anisotropic boehmite particles in a specific process for forming a coating solution. Yoshino does not disclose a surface coating solution that necessarily exhibits the claimed properties and does not disclose a process that necessarily results in a surface coating solution that exhibits the claimed properties. Thus, Yoshino does not inherently disclose the claimed surface coating solution.

Furthermore, in its limited comments on the Applicant's amendment, the PTO appears to rely on the polyvinyl alcohol examples 19-22 of Yoshino to anticipate latex paint including acrylic, as recited in claim 4. The PTO has failed to provide a reasoned statement as to why the

polyvinyl alcohol examples of Yoshino anticipate acylic latex coatings. Thus, the Final Office Action is deficient.

For at least the foregoing reasons, claims 1-4, 6-12 and 15-21 are patentable over Yoshino. As such, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §102(e) and 35 U.S.C. §103(a) rejections.

5. Claims 1-3, 8-11, 13-19, 22 and 25-33 were rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over Napier (US 3,357,791). Applicants respectfully traverse this rejection for the following reasons.

While the above rejection relies on Napier, the Final Office Action states that "Bugosh teaches" use of boehmite in aqueous coatings. Such a rejection is unclear and as a result, Applicants respectfully request a new office action.

As above, Bugosh fails to anticipate the claims. In addition, as Applicants noted in a previous Amendment, Napier fails to teach or suggest the claimed flow and leveling characteristics.

As above, the claimed flow and leveling characteristics, among others, result from the use of particular anisotropic boehmite particles in a specific process for forming a surface coating solution. Napier fails to teach or suggest a surface coating solution having the claimed flow and leveling characteristics and fails to teach or suggest a method that necessarily produces a surface coating solution having the claimed flow and leveling characteristics. As such, Napier fails to teach or suggest, either explicitly or inherently, each and every element of claims 1 and 22.

For at least the foregoing reasons, claims 1-3, 8-11, 13-19, 22 and 25-33 are patentable over Napier. As such, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §102(b) and 35 U.S.C. §103(a) rejections.

6. Claims 1-4, 6-22, and 24-34 were rejected under 35 U.S.C. §103(a) as obvious over Napier with or without Bugosh. Applicants respectfully traverse this rejection.

As above, both Napier and Bugosh fail to teach or even remotely suggest a surface coating solution having a flow and leveling characteristic of at least about 6 mils. As such,

Napier and Bugosh, alone or in combination, fail to teach each and every element of claims 1 and 22.

For at least the foregoing reasons, claims 1-4, 6-22, and 24-34 are patentable over Napier alone or in view of Bugosh. As such, Applicants respectfully request reconsideration of the 35 U.S.C. §103(a) rejection.

7. Claims 53 and 54 are newly added and recite, among other elements, activated anisotropic boehmite. The cited references are silent regarding activation of anisotropic boehmite and are silent regard use of activated anisotropic boehmite.

Applicants respectfully submit that the present application is now in condition for allowance. Accordingly, the Examiner is requested to issue a Notice of Allowance for all pending claims.

Should the Examiner deem that any further action by the Applicants would be desirable for placing this application in even better condition for issue, the Examiner is requested to telephone Applicants' undersigned representative at the number listed below.

Applicants do not believe that any additional fees are due, but if the Commissioner believes additional fees are due, the Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-3797.

Respectfully submitted,

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